



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,836	12/21/2000	Edward O. Clapper	42390P10784	8616
21906	7590	03/18/2004		
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			EXAMINER TIEU, BINH KIEN	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 03/18/2004

21

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/745,836

Applicant(s)

CLAPPER, EDWARD O.

Examiner

BINH K. TIEU

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 28 and 30-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28 and 30-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Response to Arguments in the Appeal Brief*

1. In view of the Appeal Brief filed on 02/17/2004, PROSECUTION IS HEREBY REOPENED. The rejection with new cited reference in this Office Action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Appellant's arguments filed 02/17/2004, have been fully considered and they are persuasive. The new reference is cited to teach **a card having memory for storing caller ID information for replacing the caller ID value for the telephone at which the card is used.**

The finality of the rejection of the last Office action is also withdrawn.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2643

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 28 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tasaki et al. (U.S. Pat. #: 4,879,744 as cited in the previous Office Action) in view of Snyder et al. (U.S. Pat. #: 5,784,444 also cited in the previous Office Action) and Griesmer et al. (U.S. Pat. #: 5,878,124).

Regarding claim 28, Tasaki et al. ("Tasaki") teaches a telephone calling card comprising: a memory having stored therein a unique identifying value (i.e., calling account number, card data, etc.), said memory having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card, the respective telephone number to be stored in the memory at a time later than the manufacturing of a calling card (col.1, line 48 – col.2, line 16).

It should be noticed that Tasaki fail to clearly teach said memory having stored therein a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used. However, Snyder et al. ("Snyder") teaches a telecommunications system that allows a caller to make call by using of a calling card. The system further allows the caller to manually input a plurality of predetermined messages such as messages of ICLIDTO number 208, indicia 210 and/or short message 212 as shown in figures 6 and 6A manually input to be transmitted and displayed at called party terminal (col.4, lines 20-67). Snyder does not teach the calling card stored therein caller ID information as argued by Applicant/Appellant in his remarks in the Appeal Brief. However, Griesmer et al. ("Griesmer") teaches such features in col.1, lines 42-45; col.4, lines 30-49; col.6, lines 16-21 and col.9, lines

39-57 for a purpose of reformatting telephone appearance and function information such as home country language message information for making toll calls at a foreign country.

Therefore, it would have been obvious to one of ordinary skilled in the art the time the invention was made to incorporate the use of such memory stored therein a plurality of predetermined messages, as taught by Snyder and Griesmer, in view of Tasaki, in order to establish a calling card communication with the caller identification information.

Regarding claim 30, Snyder further teaches limitations of the claim as shown in pictures 6 and 6A, col.4, lines 47-53 and col.5, lines 16-32.

Regarding claim 31, Tasaki further teaches limitations of the claim in col.1, lines 53-58.

Regarding claim 32, Snyder further teaches limitations of the claim in col.4, lines 57-56.

3. Claims 34 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griesmer et al. (U.S. Pat. #: 5,878,124) in view of Snyder et al. (U.S. Pat. #: 5,784,444).

Regarding claim 34, Griesmer et al. ("Griesmer") teaches a telephone smart card comprising:

a memory having stored therein a plurality of predetermined messages (i.e., information of the caller's identity and other caller information, col.1, lines 42-45; col.4, lines 30-49; col.6, lines 16-21 and col.9, lines 39-57) to replace the caller ID value for the telephone at which the calling card is used (col.4, lines 47-67).

It should be noticed that Griesmer teaches the smart card having memory for storing caller ID and other caller information. Griesmer fails to teach other type of card such as a calling card that allows a caller to be properly identified when calling from a payphone station.

Art Unit: 2643

However, Snyder teaches a calling card that allows caller at a payphone station to make call and to input personalized caller identification information to be transmitted and displayed at called party terminal (col.4, lines 20-67) for a purpose of providing identification information related to caller making call at a payphone station to called party.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the modification of smart card as calling card, as taught by Snyder, into view of Griesmer in order to reduce the cost of making calling card calls.

Regarding claim 40, Snyder et al. ("Snyder") teaches a telephone calling card comprising:

a memory having stored therein a plurality of predetermined messages (i.e., information of the caller's identity and other caller information, col.1, lines 42-45; col.4, lines 30-49; col.6, lines 16-21 and col.9, lines 39-57) to replace the caller ID value for the telephone at which the calling card is used (col.4, lines 47-67).

It should be noticed that Griesmer teaches the smart card having memory for storing caller ID and other caller information. Griesmer fails to teach other type of card such as a calling card that allows a caller to be properly identified when calling from a payphone station.

However, Snyder teaches a calling card that allows caller at a payphone station to make call and to input personalized caller identification information to be transmitted and displayed at called party terminal (col.4, lines 20-67) for a purpose of providing identification information related to caller making call at a payphone station to called party.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the modification of smart card as calling card with functions

Art Unit: 2643

associated with the calling card, as taught by Snyder, into view of Griesmer in order to reduce the cost of making calling card calls.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tasaki et al. (U.S. Pat. #: 4,879,744) in view of Snyder et al. (U.S. Pat. #: 5,784,444) and Griesmer et al. (U.S. Pat. #: 5,878,124) as applied to claim 28 above, and further in view of Taskett (U.S. Pat. #: 5,923,734 also cited in the previous Office Action).

Regarding claim 33, Tasaki, Snyder and Griesmer, in combination, teaches all subject matters as claimed above, except for said plurality of predetermined messages being printed on the card. However, Taskett teaches a prepaid card or phone card having visual indicia on one or both sides of the card. While connected to the service provider network, audio indicia relating to the visual indicia on the prepaid instrument is suitably communicated to the consumer at appropriate times or intervals (see Abstract, col.5, lines 15-45 and col.6, lines 47-53) for a purpose of improving a distributed system for effecting commercial telephone card transactions by a consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of teachings of the prepaid phone card imprinted with a visual indicia associated with corresponding audio indicia as predetermined message or messages printed on the card, as taught by Taskett, into view of Tasaki, Snyder and Griesmer in order to distinguish the message card with other standard calling cards.

4. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griesmer et al. (U.S. Pat. #: 5,878,124) in view of Snyder et al. (U.S. Pat. #: 5,784,444) as applied to claim 34 above, and further in view of Taskett (U.S. Pat. #: 5,923,734).

Art Unit: 2643

Regarding claim 35, Snyder and Griesmer, in combination, teaches all subject matters as claimed above, except for said plurality of predetermined messages being printed on the card. However, Taskett teaches a prepaid card or phone card having visual indicia on one or both sides of the card. While connected to the service provider network, audio indicia relating to the visual indicia on the prepaid instrument is suitably communicated to the consumer at appropriate times or intervals (see Abstract, col.5, lines 15-45 and col.6, lines 47-53) for a purpose of improving a distributed system for effecting commercial telephone card transactions by a consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of teachings of the prepaid phone card imprinted with a visual indicia associated with corresponding audio indicia as predetermined message or messages printed on the card, as taught by Taskett, into view of Griesmer and Snyder in order to distinguish the message card with other standard calling cards.

Regarding claim 36, Snyder further teaches limitations of the claim in col.4, lines 53-56.

5. Claims 37-39 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griesmer et al. (U.S. Pat. #: 5,878,124) in view of Snyder et al. (U.S. Pat. #: 5,784,444) as applied to claims 34 and 40 above, and further in view of Tasaki et al. (U.S. Pat. #: 4,879,744).

Regarding claim 37, Snyder further teaches the well-known billing format of the calling card (col.4, lines 25-32). Snyder, however, fails to clearly teach said calling card comprising said memory has a storage area therein for holding a value specifying an account balance, the account balance being stored in the memory at a time later than the manufacturing the calling card. Tasaki teaches such features in col.1, lines 53-58, col.3, lines 39-46 and col.4, lines 26-32,



Art Unit: 2643

line 2 for a purpose of allowing caller to make calls without carrying coins or cash.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the memory of the calling card having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card, as taught by Tasaki, in view of Griesmer and Snyder in order to use the telephone card as a substitute for cash payment.

Regarding claims 38 and 41, Tasaki further teaches limitations of the claim in col.1, lines 48-52 and col.1, line 64 – col.2, line 2.

Regarding claims 39 and 42, Tasaki further teaches limitations of the claim in col.1, line 64 – col.2, line 2.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: [BINH.TIEU@USPTO.GOV](mailto:BINH.TIEU@USPTO.GOV).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).

Application/Control Number: 09/745,836

Page 9

Art Unit: 2643

A handwritten signature in black ink, appearing to read "Binh Tieu", with a long horizontal line extending to the right.

**BINH TIEU**  
**PRIMARY EXAMINER**

Art Unit 2643

Date: March 16, 2004